



IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1976.

**No. 76-1109**

FOSTER GRANT CO., INC.,

*Petitioner,*

vs.

ILLINOIS TOOL WORKS, INC.,

*Respondent.*

**PETITIONER'S REPLY BRIEF**  
**In Support of Its Petition for Writ of Certiorari.**

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**RESPONDENT'S BRIEF IGNORES THE ISSUES  
RAISED IN THE PETITION.**

A review of Respondent's Brief quickly reveals that it is not at all responsive to the Petition. Instead, it ignores the issues raised in the Petition and attempts to interject two inaccurate questions that completely miss the mark. Then, although alleging a "factual dispute", Respondent only presents unsupported argument calculated to obscure the legal issues.

**PETITIONER DOES NOT CHALLENGE THE DOCTRINE  
OF STARE DECISIS.**

Petitioner submits that the stare decisis effect of the prior cases must be evenly applied to *both* Petitioner and Respondent.

Thus, if Respondent is entitled to rely on a prior holding of validity (*i.e. Continental Can*), Respondent must also be bound by the positions it took to obtain that holding. In other words, Respondent's prior definition of "rim" must be applied, in which case Petitioner does not infringe the '213 patent.

Conversely, if Respondent is not estopped by the position it took in the prior case, but is permitted to change the definition of "rim" and thus broaden the scope of the claimed invention, the prior case should no longer be given any weight on the validity issue.

#### **Rovico as Applied in This Case Is a Denial of Due Process.**

In the present case, the Court of Appeals permitted Respondent to change its definition of the critical claim element "rim" in order to find infringement and yet it affirmed the validity of the '213 patent under *Rovico*. That is, we submit, not *stare decisis*. More importantly, it is a denial of due process of law guaranteed Petitioner under the Fifth Amendment of the Constitution.

#### **Respondent Does Not Deny Its Change in Position.**

Respondent's changed definition of "rim" is a significant change in the facts which goes to the very heart of the legal issues raised by questions 1 through 6 set forth in the Petition. In its Brief in Opposition, Respondent does not deny this change in position.

#### **The New Definition of "Rim" Must Be Applied to the Prior Art.**

In its arguments concerning Flack and Aldington, Respondent fails to apply its new definition of "rim". Instead, Respondent repeats the same arguments it had used in the *Continental Can* case wherein it was asserted that the "rims" in Aldington and Flack included all that is colored red in Plate I of the Petition. However, when Respondent's *new* definition of "rim" is applied

to Aldington as shown in Plate II of the Petition, the upper stacking shoulder of Aldington is positioned below and spaced axially from the rim as required in the '213 patent claims.

#### **No "After the Fact" Tests.**

Petitioner does not rely on "After the fact tests" to establish the resiliency of Aldington's lids. As pointed out in the Petition (p. 18) both Aldington and his co-worker Rath testified at trial that stacks of these prior art lids were resilient (R. 1487-88, 1554-55). Three of the actual prior art lids (DX 135A-C) were placed in evidence. This new evidence of a prior resilient Z-shaped stacking ring was uncontradicted and *destroys* Respondent's argument that the '213 combination of old elements possessed any synergistic result.

#### **The Skill of a Mechanic.**

The level of skill required to take the stacking device of Aldington's plastic lid and use it in the plastic container of Flack or to move the "Z" shaped stacking device of the prior art rim stacker down a few fractions of an inch into the container sidewall is only that of a skilled mechanic. It falls far short of the standard set by this Court. *Graham v. John Deere Co.*, 383 U. S. 1 (1966), *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950) *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U. S. 57 (1969) *Sakrodia v. Ag. Pro, Inc.*, 425 U. S. 273 (1976).

#### **Kent Did Not Have Three Seals.**

Respondent's "three seal" argument is directed to a conceptual drawing of a container and lid which were never made (Tr. 1632). Petitioner does not rely on that drawing as prior art. Rather, Petitioner relies on the testimony of the Kent witnesses and the subsequently made containers and lids which leaked liquid when the vent notches were too wide but which

did not leak when the vents were made smaller (Tr. 1676-77, DX 179, pp. 188-190). There is no probative evidence to the contrary.

#### **Knapp v. Morss Is Also an Application of Stare Decisis.**

In the *Continental Can* case, Respondent took the position that the liquid contents in the package formed a seal upstream of the lid vents. As pointed out above, in the prior art Kent package the liquid formed a seal upstream of the lid vents just as in the infringing Continental Can package.

Under the doctrine of stare decisis and the long standing principle announced by this Court in *Knapp v. Morss*, 150 U. S. 221 (1893) the '139 patent should now be held invalid in view of the position Respondent took to find infringement in *Continental Can* because the earlier Kent packages were the same. However, the Court below did not accord any stare decisis benefits of the prior case to Petitioner while it unevenly applied its so-called *Rovico* rule in Respondent's favor. That is not due process.

#### **THE SECTION 112 REQUIREMENTS.**

##### **Written Description.**

"A rim of predetermined axial extent" is a critical element of the '213 patent claims. Yet the patent specification contains absolutely *no written description* of this portion of the claimed invention as is required in the first paragraph of 35 U. S. C. § 112 (A. 157). The decision of the Court below is clearly in conflict with the requirement that the specification contain a written description of the invention, as was enunciated by Chief Judge Marshall of this Court nearly 150 years ago in *Grant v. Raymond*, 31 U. S. 141 at 160 (1832). See also the decisions of this Court cited at page 3 of the Petition.

Apparently the Court below confused the "how to make" requirement of Section 112 with the "written description" re-

quirement of the Statute 35 U. S. C. § 112 (see A. 16-17). Respondent makes the same error at page 16 of its Brief. However, this is in direct conflict with the Court of Customs and Patent Appeals which has specifically held that these two requirements of Section 112 are distinct and independent. *In re Ahlbrecht*, 435 F. 2d 908, 911 (CCPA 1971).

No authority is cited by the Court below or in Respondent's Brief which would support Respondent's assertion that "lip" in the specification is a written description of "rim" as now used in the claims.

##### **The Best Mode.**

All of the hundreds of thousands of nestable cups that Respondent had sold before it filed the '213 parent application in October 29, 1958, had "rolled rims". Respondent's customer required it. The reason is clearly spelled out in Respondent's patent on the rim rolling machine which it had applied for in August, 1958.

"Occasionally, a sharp edge or flash is produced along the bottom edge of the rim. Any possibility of discomfort or danger from such flash is avoided, as shown in Fig. 4, by curling or rolling over the rim." (DX 75, col. 2, ll. 15-18, see Petition Plate II.)

The claim calls for "a rim of predetermined axial extent" and that axial extent is not determined until the rim is rolled.\* This best mode therefore goes directly to the invention claimed in the '213 patent.

##### **Conflict Among the Circuits.**

A review of the cases cited by Respondent will reveal that there is indeed a conflict among the Circuits regarding what is required to satisfy the "best mode" under Section 112. Does "best mode" mean the inventor's preferred embodiment at the

\* A more complete explanation of the relationship between the axial extent of the rim and the axial extent of the stacking ring is set forth in another of Respondent's patents (DX 72).

time of his application or is it something less? Is the standard subjective or objective and is it a strict one or something less? In short what is the scope of disclosure necessary for compliance? In view of the conflicting decisions and the fact that this Court has not examined the "best mode" requirement since it was made applicable to all inventions in 1952, we submit, this is an appropriate time and case for such a review.

### CONCLUSION.

This petition should be granted in order for the Court to instruct the lower courts on proper interpretation of 35 U. S. C. § 112(1) and the proper application of *Rovico* in harmony with the principles of due process, estoppel and the standard of patentability for a combination of old elements.

Respectfully submitted,

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